

R E M A R K S

Careful consideration has been given to the Official Action of February 15, 2005 and reconsideration of the application as amended is respectfully requested.

Claim Disposition

Claims 42, 43, 65, 66, 69 and 82 are rejected under 35 U.S.C. 103 as being unpatentable over Hofmann in view of Williamson.

Claims 71 and 76 have been objected to on formal grounds.

Claims 44-64, 67, 68, 70, 72, 73, 75, 77-79, 81, 83 and 85 are allowable.

Claim Action

Amendatory action has been taken in claim 42 to clearly distinguish over the applied art and thereby render this claim allowable along with its dependent claims. All other pending claims have been deemed allowable.

Additionally, amendatory action has been taken in the claims to change some of the dependencies and to cancel claims 65-69.

With respect to the objection raised against claim 71, the duplication of the word 'at' is not redundant and the expression correctly sets forth that the measurement of the

impedance takes place at at least one frequency.

Claim 76 has been amended to add the word 'to' as recommended by the Examiner.

The Examiner rejects claims 42, 43, 65,66, 69 and 82 on the combination of Hofmann and Williamson and proposes to use the control device of Williamson for 'regulating the energy of the treatment device'.

It is respectfully submitted that the combination as proposed by the Examiner is not obvious under 35 U.S.C. 103.

Hofmann discloses an electroporation apparatus in which electrodes are supplied with voltage to achieve electroporation of tissue or organs. However, the voltage source is preset and no adjustment thereof is made. Namely, the pulse generator 12 is intended to deliver optimum pre-set voltage to the electrodes and the cells. See column 8 lines 4-13 where Hofmann discloses the precise and controlled voltage obtained from the voltage source to provide optimum electroporation. As correctly noted by the Examiner, Hofmann lacks an impedance measuring unit, a registration and conversion means and an adjustable voltage generator whose output is controlled by the impedance measuring unit.

In fact, Hofmann does show adjustment of the field applied to the tissue using a pre-set constant voltage by selecting different arrays of electrodes having different spacing to which the voltage is applied. This is completely different from adjusting the voltage of the

power supply based on impedance measurement in the tissue or organs.

Williamson discloses apparatus intended for coagulating blood vessels as, for example, in a cutting and stapling instrument. A device for measuring tissue impedance is utilized to achieve blood coagulation. Williamson does not disclose anything regarding impedance measurement in connection with cell electroporation and to the benefits thereof for applying treatment medication to the cells. On the contrary, Williamson is concerned with an entirely different purpose, namely, achieving blood coagulation which is totally non-analogous to electroporation. It is therefore respectfully submitted that it would not be obvious to one skilled in the art to utilize the teachings in Williamson for the purpose of adjusting the voltage supply of the power source of Hofmann. It is emphasized again that Hofmann shows no adjustment whatsoever of the power supply and indeed contemplates that the power supply will be set at a specific and prescribed predetermined value. Williamson which adjusts the power supply on the basis of coagulation of blood has nothing whatever to do with the electroporation process of Hofmann and therefore it would not be obvious to one skilled in the art to arbitrarily assume that the power supply system of Williamson would have any beneficial or useful effect to justify altering the specific teaching of a constant power supply in Hofmann. In order to establish a justification for a rejection under 35 U.S.C. 103 as being obvious it is necessary to show that there is some direction, motivation or incentive for one to employ the teachings of a secondary reference to change the specific teaching in the primary reference. In the case at hand, since Hofmann teaches a constant voltage source and provides no adjustment of the voltage source, it does not follow that an adjustment of the voltage source, as disclosed in Williamson for an entirely different purpose,

would have any beneficial effect in the Hofmann system.

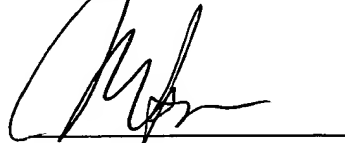
It is therefore respectfully submitted that the cited art fails to satisfy the obviousness requirements of 35 U.S.C. 103. In order to arrive at the invention as claimed in claims 42, 43 and 82, one would have to completely disregard the teachings of Hofmann in favor of the unrelated teaching in Williamson. There is no suggestion to discard the teachings in Hofmann without using applicants' own disclosure as a template, and no such suggestion can be found in the references. "To establish prima facie case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" MPEP § 2143.03. As explained above, the references do not show or suggest the limitations now present in the claims and there is no motivation or incentive in the references to do so. As held in *Ex parte Clapp* 227 USPQ 972 in order to conclude that the claimed invention is directed to obvious subject matter, the references must either expressly or impliedly suggest the claimed invention. This they cannot do since Hofmann teaches a fixed voltage and Williamson adjusts the voltage for an entirely different reason and one not remotely related to Hofmann. The Examiner justifies combining Williamson with Hofmann "to optimize patient treatment and avoid tissue damage". The optimization of patient treatment in Williamson is for the purpose of determining tissue status in respect of blood coagulation. There is no mention of "tissue damage" and the present invention is not for avoiding "tissue damage" but for controlling cell electroporation, a subject not remotely considered by Williamson.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of independent claim 42 and their dependent claims, under 35 U.S.C. §103(a).

Conclusion

By reason of the above action and comments, it is respectfully submitted that the application is now in condition for allowance and early notice thereof would be appreciated.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Julian H. Cohen', is written over a horizontal line.

JULIAN H. COHEN
c/o Ladas & Parry LLP
26 West 61st Street
New York, New York 10023
Reg. No. 20302
Tel. No. (212) 708-1887